

Remarks

Introduction

Claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, 150-162 are pending in the application.*

Claims 1, 2, 4-12, 15-30, 32-44, 60, 61, 63-71, 74-89, 91-103, 119, 120, 122-130, and 133-162 are rejected under 35 U.S.C. § 103(a) as being obvious over Israel et al U.S. Patent 6,766,307 (hereinafter "Israel") in view of Landry U.S. Patent Publication No. 2003/0014265 (hereinafter "Landry").

Claims 13, 14, 72, 73, 131, and 132 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Landry and in further view of Murray et al. U.S. Patent 5,023,851 (hereinafter "Murray").

Summary of Application History

This application was filed on November 21, 2001. A first non-final Office Action on the merits was mailed on November 12, 2004. A Reply to Office Action including amendments to the claims was filed on May 12, 2005. A second, final Office Action was mailed on July 27, 2005. A Reply to Final Office Action including amendments to the claims was filed with a Request for Continued Examination on November 28, 2005. Prior to the current submission, this November 28, 2005 Reply to Office Action was the most recent substantive paper filed in this application.

* The Office Action incorrectly identifies claims 3, 31, 62, 90, 121, and 149 as pending. However, these claims were cancelled in the Reply to Office Action dated May 12, 2005. Similarly, claims 13, 14, 72, 73, 131, and 132 are omitted from the listing of pending claims. However, these claims are pending as originally filed.

On December 19, 2005, a third non-final Office Action was mailed. This Office Action failed to address the claim amendments and the remarks of applicants' November 28, 2005 Reply to Office Action. On April 13, 2006 applicants' representative, Richard M. Feustel Jr., conducted an in-person interview with the Examiner and his supervisor. During the interview, the Examiner agreed to reconsider the pending rejection and issue a new, non-final Office Action. On April 19, 2006 applicants filed a Reply to Office Action summarizing the interview.

On July 14, 2006, a fourth non-final Office Action was mailed that did not address the merits of the application, but required restriction of the application to one of two inventions. On September 14, 2006, a Reply to Office Action was filed electing for examination the first invention.

On November 30, 2006, a fifth non-final Office Action was mailed. This Office Action also failed to address the claim amendments and the remarks of applicants' November 28, 2005 Reply to Office Action. On January 30, 2007, applicants' representatives and Richard M. Feustel Jr. and Michael J. Chasan conducted a telephonic interview with the Examiner. As a result of the interview, the Examiner agreed to reconsider the pending rejection and issue a new, non-final Office action to address applicants' pending claims and prior remarks. On February 22, 2007 applicants filed a Reply to Office Action summarizing the interview.

On May 21, 2007, a sixth final Office Action was mailed. On September 7, 2007, applicants' representative Michael J. Chasan conducted a telephonic interview with the Examiner. During the interview, the Examiner agreed to

issue a new non-final Office Action because the Examiner had not yet provided substantive examination of the claims submitted with the November 28, 2005 Reply to Office Action.

On October 31, 2007, the previous final Office Action was withdrawn and the current non-final Office Action was mailed. This Office Action is the seventh Office Action to be issued in this application. This Office Action is also the first Office Action to fully address the November 28, 2005 Reply to Office Action, which was submitted over two years prior to the current Office Action.

Applicants remind the Examiner that:

[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. M.P.E.P. § 706

Therefore, especially in light of delays in the examination of this application, applicants respectfully request reconsideration of the outstanding rejection and allowance of the present application in light of the remarks that follow.

Applicants' Reply to the Examiner's Claim Interpretation

On pages 2-5 of the Office Action, the Examiner provides several notes that generally address the Examiner's interpretation of the applicants' claims. Some of these notes do not relate to applicants' claim language. Other notes refer generally to applicants' claim language, but do not address specifically the significance of the interpretation purportedly being applied by the Examiner. Therefore, applicants' have not responded to each of these

notes individually. Instead, applicants have attempted to address the Examiner's claim interpretations as they apply specifically to the Examiner's 35 U.S.C. § 103(a) rejections, which are address below. However, it should be noted that applicants' silence as to any of these notes is not a concession by applicants that such notes are accurate and applicants reserve the right to analyze and dispute such notes in the future.

Applicants' Reply to the Rejection of
Claims 1, 60, and 119 Under 35 U.S.C. § 103(a)

Applicants' independent claims 1, 60, and 119 are directed toward a method and systems for dispute management using a dispute management application. A Case Manager user is assigned by the dispute management application to manage the dispute management process after a user files a claim against at least one party. The Case Manager is a user other than the user and the at least one party that guides the user and the party through the dispute resolution process. The dispute management application notifies the Case Manager of the assignment in response to the user filing the complaint and provides the Case Manager with a plurality of dispute management features. These dispute management features include the ability to select a neutral to facilitate the dispute resolution process.

To make out a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations of the rejected claim. MPEP § 2143. However, taken alone or in combination neither Israel nor Landry teaches or suggests a Case Manager having all of the features recited by applicants' independent claims 1, 60,

and 119. Thus, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

A. Israel Does Not Show or Suggest a Case Manager

Initially, the Examiner contends that the program manager of Israel is equivalent to applicants' Case Manager. In particular, the Examiner contends that program manager of Israel guides the user and the at least one party through the dispute resolution process, as recited by applicants' independent claims. In support for this contention, the Examiner cites, column 3, lines 13-24 of Israel, which states:

The program manager access can include a plurality of selectable actions such as, for example and not limited hereby, adding users, modifying existing user data, transferring active cases from one user to another, activating users, modifying account registration data, browsing all disputes, generating detailed dispute reports, generating summary reports of disputes, browsing dispute resolution cases, as well as other actions which are used by a manager of non-judicial dispute resolutions, and any combination of one or more of the foregoing. The management module can provide relevant data to a program manager in response to an appropriate signal selected by the program manager.

However, as applicants' previously demonstrated in the May 12, 2005 Reply to Office Action, Israel's "program managers are individuals at a company . . . responsible for maintaining the account with the present system [and] program users are individuals within those companies . . . who have the authority to settle disputes" Israel, column 11, lines 42-49. The program managers and program users are two different users from the same company that are provided different levels of access as part of that company's dispute resolution proceedings. Therefore, as representatives of a single party in a dispute (i.e., a

company), it is plain why Israel's program manager (or a program user for that matter) cannot manage the dispute resolution process and guide the other adverse party through the dispute resolution process.

The Examiner further contends that the program manager of Israel is equivalent to applicants' claimed Case Manager because the program manager is notified of their assignment to a dispute in response to the user filing the dispute, as recited by applicants' independent claims. In support for this contention, the Examiner cites column 13, lines 23-25 and column 11, lines 60-62 of Israel, which describe how the program manager may transfer active disputes from one program user to another. After the program manager initiates such a transfer, "the Program Manager will be notified that the dispute(s) have been successfully transferred from one Program User to another." Id., column 13, lines 23-25.

This functionality of Israel is not the same as or similar to applicants' claimed feature. In particular, this notification does not notify the program manager of an assignment in response to the user filing the complaint. Instead, this notification is merely a confirmation that the program manager's requested operation of transferring a case from one user to another has been completed. Furthermore, because the program manager is affiliated with a particular company it is inconceivable that the program manager would be assigned to a dispute after a program user who is also affiliated with the company files a dispute on behalf of the company. Rather the program manager is inherently associated with the dispute and therefore cannot be assigned to the dispute in the same manner as applicants' claimed Case Manager.

Finally, the Examiner further contends that the program manager interacts with a management module and that this interaction is equivalent to applicants' claimed feature of allowing the Case Manager to select a neutral to facilitate the dispute resolution process. The Examiner cites s, column 10, lines 13-20 of Israel to describe the features of this management module:

Additionally, the management module 5 is configured to transmit notices to each party to a dispute regarding a change in the status of the dispute, the input of additional data in relation to the dispute, the results of a query of the data contained within management module, or any other information relating to the dispute and/or for transmitting the dispute resolution data to the appropriate entity for mediation and/or arbitration.

However, there is nothing in this portion of Israel or anywhere else in Israel that shows or suggests that a neutral can be appointed by the program manager (with or without using the management module). Additionally, because the program manager is in fact a representative of one of the interested parties to the dispute, it is not possible that the program manager would be given this ability.

Therefore, for at least these reasons, applicants' submit that Israel does not provide the features of a Case Manager as recited by applicants' independent claims. In particular, Israel is a "do-it-yourself" system in which users must attempt to guide themselves through the dispute management process without the assistance of a Case Manager.

B. Landry Does Not Show or Suggest a Case Manager

After attempting to demonstrate how the program manager of Israel shows all of the features of applicants'

claimed Case Manager user, the Examiner concedes that "Israel did not explicitly teach a system in which another user provides guidance/management or supports to a dispute resolution system." Office Action, page 10. In an attempt to overcome this deficiency, the Examiner has pointed to Landry to show these features.

Landry refers to an online dispute resolution system that includes an ODR System Clerk. The Examiner contends that the this clerk of Landry "performs the similar functions to the case manager." *Id.* However, this clerk does not show or suggest all of the features of applicants' claimed Case Manager.

In particular, Landry describes the ODR System Clerk as follows:

The System Clerk 114 ("Clerk") accesses all of the ODR System services (except the ODR services 102) for purposes of globally maintaining and monitoring the ODR System 60 processes, registering e-merchants, and enrolling mediators and arbitrators; these system services include merchant enrollment 108, monitoring service 96, system administration 90, and arbitrator/mediator enrollment 112. The Clerk 114 is responsible for administering the ODR System 60 using the system administration service 90; this service enables the Clerk 114 to administer access rights, manage multi-lingual interfaces, and manage archived materials. The Clerk 114 accepts the registration of mediators 130 and arbitrators 128 into the ODR System 60 using the arbitrator/mediator enrollment service 112 (the arbitrator/mediator enrollment service 112 is described in detail below). The Clerk 114 accepts the registration of merchants 80 in the ODR System 60 using the merchant enrollment service 108 (described in detail below). The Clerk 114 monitors the ODR System processes using monitoring service 96; this service enables the Clerk to verify the validity of the Arbitration/Mediation Clause (discussed below), and to generally provide support to parties during ODR processes (e.g.,

providing assistance in completing and submitting electronic forms).

Landry, paragraph 30. The ODR System Clerk is therefore an administrative user that is akin to technical support. The clerk "is responsible for administering the ODR System" and " monitor[ing] the ODR System processes." *Id.* The clerk does not guide the user and the other party through the dispute resolution process, is not assigned to manage a dispute and notified of their appointment, and does not select a neutral party. Therefore Landry's clerk does not show or suggest all of the features of applicants' claimed Case Manager.

While the Examiner does not address all of these features of applicants' claims individually, the Examiner lists particular tasks of the clerk as allegedly showing a the features of applicants' claimed Case Manager. These tasks include, enabling the clerk to verify the validity of the Arbitration/Mediation Clause and providing support to parties during ODR processes. Applicants submit that these features are administrative in nature and merely allow the clerk to monitor the ODR process and provide limited enrollment assistance to the users. In fact, the clerk is specifically not provided access to the substantive ODR services (*see Id.* and FIG. 2A, element 102) which performs the substantive elements of the ODR processes. Thus, even if the clerk is provided with some features that enable the clerk to directly assist both parties with certain basic tasks (e.g., filling out forms), there is nothing in Landry that shows or suggest that the clerk is able to guide the user and the at least one party through the dispute resolution process itself.

However, given the Examiner's claim interpretation (to which applicants' do not agree), even if

Landry's clerk were able to guide the user and the at least one party through the dispute resolution process (which applicants' maintain it does not), the clerk is still not able to select a neutral to facilitate the dispute resolution process. In fact, the clerk is only able to initially screen and enroll the mediators that will be used by the ODR system. Once enrolled, approved mediators are added to a mediator database. The actual selection of mediators for a particular case is performed automatically by the ODR System Program and not by the clerk. See Landry, paragraphs 61 and 62.

Therefore, Landry's clerk does not select the neutral for facilitating the dispute resolution process between the user and the party. Thus, Landry also does not provide the benefits of a Case Manager user as specified by applicants' independent claims.

C. The Combination of Israel and Landry
Do Not Show or Suggest a Case Manager

As demonstrated above, neither Israel nor Landray show or suggest a Case Manager user as recited by applicants' independent claims. In particular, the program manager of Israel is not a separate party, but merely a user who is associated with the user who files the complaint. The program manager of Israel therefore cannot provide any of the features of the Case Manager as recited by applicants' claims. Landry's ODR System Clerk also does not show or suggest the features of the Case Manager as recited by applicants' claims. Rather, Landry's clerk is merely an administrative user does not have access to substantive elements of the ODR processes. Furthermore, Landry's clerk does not select a neutral party to facilitate the dispute resolution process.

Therefore, even if the combination of Israel and Landry were proper, this combination still does not show or suggest "assigning a case manager, who is a user other than the user or the at least one party. . . in response to receiving [the user's indication to file a claim against the at least one party, to guide] the user and the at least one party through the dispute resolution process . . . notifying the case manager of the assignment . . . [and] allowing the case manager to select a neutral," as recited by applicants' independent claims 1, 60, and 119.

D. Conclusion

Accordingly, because Israel and Landry, whether taken alone or in combination, fail to show or suggest all of the features of applicants' independent claims 1, 60, and 119, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Applicants' Reply to the Rejection of
Claims 29, 88, and 147 Under 35 U.S.C. § 103(a)

Applicants' method and systems of independent claims 29, 88, and 147, are directed towards, generally speaking, providing dispute management features in a dispute management application that includes providing a case filing application for allowing users to file a claim and a Case Manager for managing the dispute. In particular, the Case Manager indicates a dispute management feature for a dispute management application and that feature is provided to the user. For example, after a claim is filed, the appointed Case Manager may select on-call mediation as the dispute management feature which is then provided to the user.

Israel does not show or suggest any of the features of applicants' independent claims 29, 88, and 147. As described above with respect to independent claims 1, 60, and 119, in the "do-it-yourself" system of Israel a Case Manager is not used. Instead, the users of Israel must attempt to guide themselves through the dispute management process without the assistance of any such user.

Landry also does not show or suggest any of the features of applicants' independent claims 29, 88, and 147. In particular, the clerk of Landry does not indicate a dispute management feature which is provided to the user. Rather, Landry's clerk is merely an administrative user and does not have access to substantive elements of the ODR processes.

Accordingly, because Israel and Landry, whether taken alone or in combination, fail to show or suggest all of the features of applicants' independent claims 29, 88 and 147 the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Applicants' Reply to the Rejection of the Dependent Claims

The remaining dependent claims all depend from claims that are novel and non-obvious over the prior art. Accordingly, for at least this reason (and applicants reserve the right to argue additional reasons should prosecution continue), the rejection of these claims should be withdrawn.

Contingent Request for Telephonic Interview

If for any reason the Examiner is unable to allow this application based on this Reply, applicants request a

telephonic interview with the Examiner before issuance of the next Office Action.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

/Michael J. Chasan/
Michael J. Chasan
Registration No. 54,026
Agent for Applicants

Ropes & Gray LLP
Customer No. 1473
Tel.: (212) 596-9000